

## REMARKS/ARGUMENT

Applicant responds herein to the Office Action dated October 1, 2002.

Responsive to the objection to claim 12 under 37 CFR 1.75(c), that claim has been canceled. The applicant has further reviewed the application and has also canceled claim 21, to which the remarks to claim 12 are also applicable.

Responsive to the rejection of claim 22 and claims 13 and 23-24 which depend thereon, under 35 U.S.C. §112, second paragraph, as set forth at paragraphs 11-12 of the Office Action, claim 22 has been amended to provide the proper antecedent basis. Reconsideration and withdrawal of this objection under 35 U.S.C. §112, are accordingly requested.

Substantively, independent claim 14 stands rejected on grounds of obviousness over Fujimori (5,027,214), in view of Okauchi (5,907,353). Claims 15-17 and 25-28 stand rejected on grounds of obviousness over Fujimori in view of Moghadam (5,682,197). Claim 18 stands rejected on grounds of obviousness over Fujimori in view of Moghadam and further in view of Udagawa (6,195,125). Claims 20 and 12 stand rejected on grounds of obviousness over Moghadam in view of Udagawa. Claim 22 stands rejected on grounds of obviousness over Moghadam in view of Udagawa, further in view of Fujimori. Claims 13 and 23-24 stand rejected on grounds of obviousness over Moghadam in view of Udagawa, further in view of Fujimori and Okauchi (5,907,353). Reconsideration of these rejections on art is requested in view of the amendments to the claims herein and the following remarks.

In the independent claims that have been rejected, it is recited that the user of the camera is provided with a “warning” that he cannot take another panoramic picture. The term “panoramic” refers to a picture that is in itself composed of a plurality of pictures, i.e., images. The gravamen of this submission is that contrary to the Office Action, the prior art of record does not, in fact, teach or suggest that aspect of the invention.

Numerous prior art cameras indicate to the camera operator how many pictures are left to be taken or how many pictures have been taken. But none of the prior art of record generates a warning that is based on the number of frames or images that are pre-assigned to a composite panoramic image and a warning that issues to the user, when the user is about to take another panoramic picture.

The warning apprizes the user that there is not enough memory space to take the number of pictures that are assigned to one composite panoramic picture.

The logic or rationale of the Office Action is that, since it is known in the art to indicate how many pictures are remaining, it would be obvious or logical to one skilled in this art, to proceed in accordance with the teachings of the invention.

The fundamental point in the applicant's traverse of the rejection of record is that the Examiner is impermissibly using his knowledge of the specific features of the present invention to engage in a hindsight-based, logical exercise to arrive at the present invention. Applicants contend that the prior art does not contain the necessary disclosure to combine the teachings of the cited Fujimori and Okauchi teachings and, more importantly, contends that even when the teachings of the references are combined, they fall short of arriving at the present invention.

It is important to note that the camera of the present invention issues a warning when there is still sufficient space in the replaceable memory to hold a plurality of images. The point at which the warning is based on a calculation that takes into consideration the number of preset images assigned to a panoramic view. Therefore, even though the image counter may show several images still available, the warning will nonetheless be issued based on the comparison to the preset number of images that it takes to create a panoramic view.

It is that applicant's contention that even when the references cited in the Office Action are combined, the warning will be issued only when the space in the memory card is insufficient to take a single image. It will never be issued in a situation where there is sufficient space to take multiple images, according to the prior art teachings.

Accordingly, the applicant respectfully disagrees with the Examiner's statement at page 6 of the Office Action (five lines from the bottom of the page), where the Examiner states that the warning means of the Fujimori reference lets the user know that the amount of memory remaining may not be sufficient for "recording the image or images..." (emphasis added). In fact, the text at column 7, lines 11-21 does not refer to plural images. It refers to a single image, and the warning may be issued based on either the space necessary to take the maximum size image or an average size image, never on the basis that there is insufficient memory to take a plurality of images.

While the applicant does not necessarily agree that the secondary reference Okauchi describes a panoramic camera, the applicant will agree that panoramic cameras as such are known in the art.

Still, even the combined teachings of the two references still fails to teach a structure that results in the claimed invention. Thus, it is ~~only-through-a-hindsight-based~~, logical leap, that the Examiner states at page 7 of the Office Action (commencing 10 lines from the bottom of the page): “Since the number of images to be taken is derived in Okauchi, it would have been obvious to compare the number of images derived and compare it to the number of images remaining in the memory and to generate a warning according to the comparison as discussed in Fujimori.” In fact, the only “accounting” of images in Okauchi is for the purpose of associating images with one another for a particular purpose. It is never for the purpose of comparing the number of images remaining in the replaceable memory to the present number that defines how many images constitute a panoramic view. This amounts to hindsight reconstruction of the present invention.

Nowhere in the cited prior art is there any disclosure that evinces recognition of either the problem or the solution of the present invention. The problem of the present invention arises from the fact the ordinary photographer who might see that there are a number of images to be taken would not be alerted to the possibility that that number is insufficient for taking a panoramic photographic of a scene. The camera itself will begin taking a photograph and only “discover” in the middle of the recording session, that there is insufficient memory to complete the operation. This causes great inconvenience, and loss of utility to the ordinary photographer. The prior art, even when combined, does not teach the concept of issuing a warning when there is still sufficient space in the memory card for a plurality of images.

Hindsight reconstruction of an invention is improper. “To imbue one of ordinary skill in the art with knowledge of the invention when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to insidious effect of a hindsight syndrom, wherein that which only the inventor taught is used against its teacher”. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1543 (Fed. Cir. 1983) 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Moreover, given that the problem solved by the invention is not even recognized by the prior art, the question arises whether it would have been obvious to combine the teachings of these

references in the first instance. As the predecessor court for the Federal Circuit has stated in its opinion in *In Re Schaeffer*, 108 U.S.P.Q. 326, 321 (CCPA, 1956):

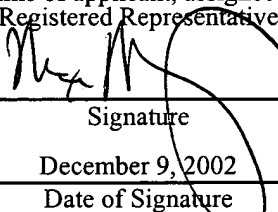
Therefore can it be said that these references which never recognize the Appellant's problem would have suggested its solution? We think not, and therefore feel that the references were improperly combined, since there is no suggestion in either of the references that they can be combined to produce appellant's result."

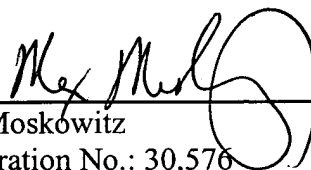
With specific reference to the various ones of the independent claims, they recite a "predicted number of setting means" that allow a user to preset a number of panoramic images frames for forming a panoramic image. That feature is not taught in the prior art. All of the dependent claims incorporate all of the limitations of the independent claims from which they derive and impose further limitations thereof. Thus, it is submitted that all of the claims in the application are clearly patentable over the prior art of record.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on December 9, 2002

Respectfully submitted,

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Signature  
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December 9, 2002  
Date of Signature

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## APPENDIX A

"CLEAN" VERSION OF EACH PARAGRAPH/SECTION/CLAIM  
37 C.F.R. § 1.121(b)(ii) AND (c)(i)

### CLAIMS (with indication of amended or new):

22. (AMENDED) An electronic photographing device, comprising:

a panoramic photographing apparatus which records panoramic images each composed of a plurality of associated panoramic image frames and image information corresponding to at least a first panoramic image frame of a set of panoramic image frames photographed by panoramic photographing onto a recording medium, and which records image information corresponding to a subsequent panoramic image frame of the set onto the recording medium; wherein the panoramic photographing apparatus includes:

a photographing information storage element for storing photographing conditions of the first panoramic image frame of the set of panoramic image frames; and

a control element for photographing the subsequent panoramic image frame according to the stored photographing conditions of the first panoramic image frame;

wherein the photographing conditions include at least one of photometric information, white balance information, a focusing setting, exposure information, and a rotation direction,

wherein the panoramic photographing apparatus further comprises:

a calculation element for calculating a remaining number of panoramic image frames which can be recorded on the recording medium based on an entire capacity of said recording medium and a capacity which has been used to obtain a remaining capacity of said recording medium; and

a warning generator for generating a warning when the remaining number of panoramic image frames which can be recorded on the recording medium is less than a predetermined number.

**APPENDIX B**  
**VERSION WITH MARKINGS TO SHOW CHANGES MADE**  
**37 C.F.R. § 1.121(b)(iii) AND (c)(ii)**

**CLAIMS:**

22. (AMENDED) An electronic photographing device, comprising:  
a panoramic photographing apparatus which records panoramic images each composed of  
a plurality of associated panoramic image frames and image information corresponding to at  
least a first panoramic image frame of a set of panoramic image frames photographed by  
panoramic photographing onto a recording medium, and which records image information  
corresponding to a subsequent panoramic image frame of the set onto the recording medium;  
wherein the panoramic photographing apparatus includes:

a photographing information storage element for storing photographing conditions of the  
first panoramic image frame of the set of panoramic image frames; and

a control element for photographing the subsequent panoramic image frame according to  
the stored photographing conditions of the first panoramic image frame;

wherein the photographing conditions include at least one of photometric information,  
white balance information, a focusing setting, exposure information, and a rotation direction.

[An electronic photographing device according to claim 20,] wherein the panoramic  
photographing apparatus further comprises:

a calculation element for calculating a remaining number of panoramic image frames  
which can be recorded on the recording medium based on an entire capacity of said [first]  
5 recording medium and a capacity which has been used to obtain a remaining capacity of said  
recording medium; and

a warning generator for generating a warning when the remaining number of panoramic  
image frames which can be recorded on the recording medium is less than a predetermined  
number.